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| APPLICATION NO.              | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|------------------------------|-------------|----------------------|---------------------------|------------------|
| 10/804,326                   | 03/18/2004  | Stephen Robertson    | 14917.0135US01/MS306779.0 | 7299             |
| 27488                        | 7590        | 12/10/2008           |                           |                  |
| MERCHANT & GOULD (MICROSOFT) |             |                      | EXAMINER                  |                  |
| P.O. BOX 2903                |             |                      | COLAN, GIOVANNA B         |                  |
| MINNEAPOLIS, MN 55402-0903   |             |                      |                           |                  |
|                              |             |                      | ART UNIT                  | PAPER NUMBER     |
|                              |             |                      | 2162                      |                  |
|                              |             |                      | MAIL DATE                 | DELIVERY MODE    |
|                              |             |                      | 12/10/2008                | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/804,326 | <b>Applicant(s)</b><br>ROBERTSON ET AL. |  |
|                              | <b>Examiner</b><br>GIOVANNA COLAN    | <b>Art Unit</b><br>2162                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-11 and 13-16 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/25/2008, 07/03/2006, 03/18/2004</u> .                      | 6) <input type="checkbox"/> Other: _____                          |



### **DETAILED ACTION**

1. This action is issued in response to applicant response to election filed 09/02/2008.
2. Claims 4, 12, 17 – 50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 09/02/2008.
3. No claims have been amended. No claims were added. Claims 4, 12, 17 – 50 were canceled.
4. Claims 9 – 11, and 13 – 16 are allowed.
5. Claims 1 – 3, and 5 – 8 are pending in this application.

### ***Continued Examination Under 37 CFR 1.114***

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/11/2006 has been entered.

***Claim - 35 USC § 101***

7. For purposes of examination, the term “computer-readable storage medium” recited in claims 9 – 11, and 13 – 16 has been interpreted as a combination of hardware and software (see: [0074], Specification of the disclosure).

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1 – 3, and 5 – 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 recites a “method of determining a field-weighted score for a document”. However, this method/process fails to: (1) tied to another statutory class (such as a particular apparatus) and (2) transform underlying subject matter (such as an article or materials) to a different state or thing (*In re Bilski*, 88 USPQ2d 1385 (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). Therefore, the method recited in claim 1 is not patentable eligible processes under 35 USC § 101 since they are directed to non-statutory subject matter.

***REASONS FOR ALLOWANCE***

10. Claims 9 – 11, and 13 – 16 are allowable in light of the applicant's arguments and in light of the prior art made of record.

***Reason for Indicating Allowable Subject Matter***

11. The following is an examiner's statement of reasons for allowance: Upon searching a variety of databases, the examiner respectfully submits that "determining a field weight for each of the determined fields, wherein the field weight corresponds to a number of times for replicating the content of each of the determined fields; replicating the content of each of the determined fields the number of times indicated by the field weight for each of the determined fields, wherein the replicated content of each field is concatenated into a field for each of the determined fields; combining each concatenated field set for each field of the document to generate a virtual document including each concatenated field set for each field of the document" in conjunction with all other limitations of the dependent and independent claims are not taught nor suggested by the prior art of record. Therefore, all pending claims 9 – 11, and 13 – 16 are hereby allowed.

12. Any comments considered necessary by applicant must be submitted no later than the payment of the issues fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### **Points of Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIOVANNA COLAN whose telephone number is (571)272-2752. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Giovanna Colan  
Examiner  
Art Unit 2162  
December 02, 2008

/Shahid Al Alam/  
Primary Examiner, Art Unit 2162